



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/498,944	02/04/2000	Christopher Warnock	EBRY0001	9493
22862	7590	09/03/2008		
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			EXAMINER LE, NANCY LOAN T	
			ART UNIT	PAPER NUMBER
			3621	
			MAIL DATE	DELIVERY MODE
			09/03/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/498,944	Applicant(s) WARNOCK ET AL.	
	Examiner NANCY T. LE	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 15, 17-21, 55-75 and 78-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 15, 17-21, 55-75 and 78-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20 November 2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

Applicant's request for reconsideration filed on *11 February 2008* is acknowledged. The final rejection mailed Sept 10, 2007 is hereby withdrawn. A new office action is set forth below.

All references to the capitalized versions of "Applicants" refer specifically to the Applicants of record. Any references to lower case versions of "applicant" or "applicants" refer to any or all patent "applicants". Unless expressly noted otherwise, references to "Examiner" refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally.

This paper is given Paper No. 20080818 by the Examiner. This Paper No. is for reference purposes only.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on *20 November 2007* was in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Status of Claims

Claims *1-3, 15, 17-21, 55-75 and 78-85* have been examined and pending.

Response to Arguments

Applicant's arguments, filed *11 February 2008*, with respect to the final rejection of *claims 1 and 67* under LeBourgeois (WO 98/42098) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground of rejection is made in view of U.S. Patent No. 5,933,498 (Schneck et al.; hereafter "Schneck '498") as follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1 and 67 are rejected under 35 U.S.C. §102(a) as being anticipated by **U.S. Patent No. 5,933,498 (Schneck et al.; hereafter "Schneck '498")**.

As per **claim 1**, Schneck discloses a computer-implemented method for user access to document content using a logic client device comprising:

- delivering to a user of said client logic device, via a document server, a first user viewable version of the actual contents of a specific document residing at a said document server on a first cost basis, said first user viewable version being protected by a security server to prevent the user from performing a standard operation on said version, said standard operation consisting of any of copying, printing or saving (*i.e., For example, initially, if a user is accessing a*

*textual document, the user may choose to access only selected portions of that document, the choice being made by viewing an index of the document – **Schneck ‘498, col. 15 ll. 8 – 18; col. 17 ll. 35 – 53**);*

- calculating with said document server a charge to permit the user to perform a requested standard operation on a user-selected portion of said specific document on a second cost basis (***Schneck ‘498, col. 25 ll. 6 – col. 29 ll. 25***);
- delivering to said user, via said document server, a second version of the actual contents of said specific document residing at said document server comprising said user-selected portion of said specific document, wherein a user requested standard operation is completed, in coordination with said document server, upon payment of the calculated charge (***Schneck ‘498, col. 25 ll. 6 – col. 29 ll. 25***).

As per **claim 67**, Schneck discloses a computer-implemented method for purchasing information from a server, comprising:

- delivering user-requested pages of a specific document from a document server in a first user-viewable version comprising a form protected by a security server to a user of a client logic device to permit said user viewing the actual contents of said pages of said specific document and selecting by said user but not printing, copying or saving by the user (***Schneck ‘498, col. 15 ll. 8 – 18; col. 17 ll. 35 – 53***);

- calculating a charge with said document server to permit a requested standard operation to be performed on a user-selected portion of said specific document (*Schneck '498, col. 25 ll. 6 – col. 29 ll. 25*); and
- delivering to said user via said document server a second version of the actual contents of said specific document, said second version consisting of the user-selected portion of said specific document, said delivering step being performed in coordination with said security server upon authorization of payment of the calculated charge, said second version comprising a version on which the standard operation is performed (*Schneck '498, col. 25 ll. 6 – col. 29 ll. 25*).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent No. 5,673,316 (Auerbach)

US Patent No. 7,290,285 B2 (Auerbach)

US Patent No. 6,289,450 B1 (Pensak)

US Patent No. 6,185,684 (Pravetz)

US Patent No. 6,345,279 (Li)

US Patent No. 5,737,599 (Rowe)

US Patent No. 5,625,711 (Nicholson)

Examiner has cited particular columns and line numbers and/or paragraph and/or page numbers in the prior arts of record as applied to the claims above in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to fully consider the references in its **entirety** as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to NANCY T. LE whose telephone number is **(571) 272-7066**. The examiner can normally be reached on Monday - Friday, 9:00am - 6:00pm Eastern Standard Time Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANDREW J. FISCHER can be reached on **(571) 272-6779**.

For official/regular communication, the fax number for the organization where this application or proceeding is assigned is **(571) 273-8300**.

For informal/draft communication, the fax number is **(571) 273-7066 (Rightfax)**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 3621

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197 (toll-free)**.

NANCY T. LE
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621